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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,786	11/21/2003	Charles Douglas Ball	RPS920030189US1	1539
55128	7590	02/09/2007	EXAMINER	
VANLEEUWEN & VANLEEUWEN			SHAN, APRIL YING	
P.O. BOX 90609			ART UNIT	PAPER NUMBER
AUSTIN, TX 78709-0609			2135	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/718,786	BALL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	April Y. Shan	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 November 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>21 November 2003</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Claims 1-30 have been examined.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 21-30** are directed to a computer program product. However, the computer program product is software, *per se* to one of ordinary skill in the art. There is no element positively recited as part of the computer product in the claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2135

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kern et al. (U.S. Patent No. 6,336,187) in view of Kohara et al. (U.S. Pub. No. 2003/0182566)

As per **claims 1 and 11**, Kern et al. discloses a method/apparatus comprising:

Encrypting (“encoding” – e.g. col. 10, line 12 and “public key encryption” – e.g. col. 10, line 30) a plurality of non-volatile storage regions (“..The storage 108 may be implemented by one or more storage devices of various types, such as magnetic disk drive, magnetic tape, optical disk...” – e.g. col. 5, line 60 – col. 6, line 4 and “The nonvolatile storage 206 may comprise, for example, one or more magnetic data storage disks such as a “hard drive”, a tape drive, or any other

suitable storage device" – e.g. col. 6, lines 23-25), each being encrypted using a different ("...initially storing a security key in association with a storage region..." – e.g. abstract and col. 1, lines 46-49) encryption key ("As an enhancement to the embodiment described above, the controller 106 may direct the storage 108 to employ the reference access key in encoding or decoding data during the storage operation of step 516. In this embodiment, if the requested storage area is protected (i.e., it has an associated reference access key), and the host-submitted input access key is valid, the controller 106 uses the access key to encode or decode data involved in the storage access operation... Encoding and decoding in this embodiment may use a number of different techniques that are well known to those in the relevant art. For instance, one useful technique is public key encryption. By using such encoding/decoding, stored data enjoys two levels of protection....by encoding data of the storage region with the key" – e.g. col. 10, lines 10-35);

granting the first user ("one or more hosts" – e.g. abstract. Please note one or more hosts corresponds to Applicant's first user and second user) access to a corresponding first subset of non-volatile storage regions (e.g. col. 2, line 64 - col. 3, line 9) and making a second subset of the encryption keys available to a second user thereby granting the second user ("one or more hosts" – e.g. abstract. Please note one or more hosts corresponds to Applicant's first user and second user.) access to a corresponding second subset of non-volatile storage regions (e.g. col. 2, line 64 - col. 3, line 9).

Kern et al. does not disclose expressly the encryption key is from a set of encryption keys, making a first subset/second subset of the encryption keys available to the first user/second user thereby granting the first user/second user, the first/second subset of the encryption keys consisting of one, a plurality, or all of the encryption keys.

Kohara et al. discloses the encryption key is from a set of encryption keys, making a first subset/second subset of the encryption keys available to the first user/second user and the first/second subset of the encryption keys consisting of one, a plurality, or all of the encryption keys (e.g. paragraphs [0010] - [0012] and abstract)

Kern et al. and Kohara et al. are analogous art because they are from the same field of endeavor of protecting data stored on nonvolatile storage section.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the encryption key is from a set of encryption keys, making a first subset/second subset of the encryption keys available to the first user/second user into Kern et al.'s method/apparatus.

The motivation of doing so would have been "generated plural encryption keys make a very low probability of occurrence of an identical encryption key because the pseudorandom number is used for the encryption key c. Consequently, allocation of the generated latest encryption key to the user can differ the plural encryption keys allocated at the different generation timings of the pseudorandom numbers at a high probability. This allows data encryption keys, and it is possible to store plural kinds of encrypted data, each of which has

a different encryption key, in the nonvolatile storage section" and "to prevent the non-interested persons from recognizing stored data in a nonvolatile storage medium in chain manner", as taught by Kohara et al. (paragraphs [0007] and [0012])

As per **claims 2 and 12**, the combined teachings of Kern et al. and Kohara et al. disclose a method/apparatus as applied above in claims 1 and 11. Kern et al. further discloses comprising:

generating a first private-public encryption key pair and a second private-public encryption key pair ("public key encryption" – e.g. col. 10, line 30. Please note to a person with ordinary skill in the art that public key encryption is an asymmetric algorithm are designed so that the key used for encryption is different from the key used for decryption. Therefore, it must generate a key pair for the first user and the second user);

making the first private key available only to the first user and the second private key only to the second user (e.g. col. 7, lines 49-59); and

encrypting the first subset of the encryption keys using the first public encryption key, and the second subset of the encryption keys using the second public encryption key (e.g. col. 10, lines 27-35).

As per **claims 3 and 13**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 2 and 12. Kern et al. further discloses comprising:

storing the first private key and the second private key in a secure memory unit (

Kern et al. – e.g. col. 5, lines 33-48);

protecting access to the first private key with a first authentication token, the first authentication token being known only to the first user (e.g. col. 9, line 63 – col. 10, line 9); and

protecting access to the second private key with a second authentication token, the second authentication token being known only to the second user (e.g. col. 9, line 63 – col. 10, line 9).

As per **claims 4 and 14**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 3 and 13.

Kern et al. further discloses comprising:

requesting an authentication token from a user attempting to access one or more of the non-volatile storage regions (e.g. col. 2, line 64 – col. 3, line 9); authenticating the user, if the user's authentication token matches one of the authentication tokens used to protect access to one of the private keys (e.g. col. 2, line 64 – col. 3, line 9);

decrypting, with the secure encryption module using the authenticated user's private key, a corresponding subset of encryption keys, in response to authenticating the user (e.g. col. 10, lines 10-35); and

decrypting a corresponding subset of non-volatile storage regions, thereby making the corresponding subset of non-volatile storage regions available to the authenticated user (e.g. col. 10, lines 10-35).

As per **claims 5 and 15**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 3 and 13. Kern et al. further discloses wherein the authentication tokens are selected from the group consisting of: passwords, fingerprints signatures, voice signatures, retina signatures, and secure access devices (e.g. col. 7, lines 49-62).

As per **claims 6 and 16**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 4 and 14. Kohara et al. further discloses wherein the encrypting and decrypting the plurality of non-volatile storage regions are performed using full-disk encryption software (“In an encryption storage apparatus...” – e.g. abstract).

As per **claims 7 and 17**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 1 and 11. Kern et al. further discloses wherein one of the non-volatile storage regions is adapted to store an operating system and data common to the first user and to the second user (e.g. col. 1, lines 45-50 and col. 1, lines 59-65).

As per **claims 8 and 18**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 1 and 11. Kern et al. further discloses wherein one of the non-volatile storage regions is

adapted to store user-specific data of the first user (e.g. col. 1, lines 45-46 and lines 49-50).

As per **claims 9 and 19**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 1 and 11. Kern et al. further discloses wherein one of the non-volatile storage regions is adapted to store user-specific data of the second user (e.g. col. 1, lines 45-46 and lines 49-50).

As per **claims 10 and 20**, the combined teachings of Kern et al. and Kohara et al. discloses a method/apparatus as applied above in claims 1 and 11. Kern et al. further discloses wherein the non-volatile storage regions are chosen from the group consisting of: volumes, disks, partitions, and folders/directories (“..The storage 108 may be implemented by one or more storage devices of various types, such as magnetic disk drive, magnetic tape, optical disk...” – e.g. col. 5, line 60 – col. 6, line 4 and “The nonvolatile storage 206 may comprise, for example, one or more magnetic data storage disks such as a “hard drive”, a tape drive, or any other suitable storage device” – e.g. col. 6, lines 23-25).

As per **claims 21-30**, the combined teachings of Kern et al. and Kohara et al. discloses the claimed method of steps as applied above in claims 1-10. Therefore, the combined teachings of Kern et al. and Kohara et al. disclose the claimed computer program product for carrying out the method of steps.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1 February 2007  
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